

EXPEDITED PROCEDURE – EXAMINING GROUP 2165

Serial No. 10/751,269

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Forrest Rhoads et al.	Examiner:	Farhan M Syed
Serial No.:	10/751,269	Group Art Unit:	2165
Filed:	December 30, 2003	Docket No.:	962.016US1
Title:	KNOWLEDGE-MANAGEMENT SYSTEMS FOR LAW FIRMS		

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed September 6, 2007, applicant submits respectfully an accompanying Notice of Appeal and this request for review. The review is requested for the reason(s) provided below.

In the Final Office Action, claims 1-14 were finally rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Rivette (U.S. 5,991,751). The applicant respectfully disagrees, seeks reversal of this rejection, and files this Pre-Appeal Brief in support thereof.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. The identical invention must be shown in as complete detail as is contained in the ...claim. (Citations omitted.)

Reasons for Reversing Rejection of Claims 1-14

Among other things, claims 1-9 generally recite means responsive to a query for searching first and second databases, with the first and second databases having specific types of documents. More particularly, these claims require that the “first database ... for the law firm include[e] briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database ... include[e] case opinions, court documents, law review articles, statutory materials, or legislative histories.” Claims 10-14 also include language requiring briefs, client correspondence, advisory opinions, or legal memorandum.

Applicant noted in the Amendment filed on June 15, 2007, that a computer search of Rivette's text revealed zero occurrences of the terms: brief, opinion, advisory, memorandum, or memoranda. Applicant further noted that because there was no teaching of these specific types of documents, one of skill in the art would not regard Rivette as identically meeting each and every limitation of the claims. As such, Rivette failed to anticipate the claims.

Nevertheless, the Examiner has elected to finalize the rejection, in essence arguing (at page 10 of the Final Rejection) that the applicant is merely relying on a statement of use to distinguish over Rivette. However, applicant submits respectfully that the highlighted limitations are not recited as statements of use, but as positive features.

Accordingly, applicant requests respectfully that the rejection of claims 1-14 based on Rivette be reversed.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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6 Mar 2008

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelop addressed to: MS Appeal Brief – Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this ____ day of March 2008.

Name

Signature